

Application No.: 10/040,141
Attorney Docket No.: TOK00-006
Response Dated: January 12, 2006
Reply for Office Action Dated: 13 July 2005

REMARKS

Claims 1-61 are pending in the application.

The Examiner has objected to the specification as allegedly failing to provide proper antecedent basis for the claimed subject matter. The objection is based on the following claim recitations: "means for facilitating selection of said fuel dispenser options" (claims 1 and 21); "means for displaying" (Claims 1 and 21); "means for saving data" (Claim 1); "means for transferring" (Claims 1 and 21); and "means for selecting" (Claim 21).

For the reasons below, Applicant respectfully submits that the specification provides clear and full support and antecedent basis for the claim recitations referenced by the Examiner.

In one illustrative form of the invention, the manner and means of "displaying" fuel dispenser options retrieved from a database, "selecting" the options, "saving" the selected options as a customized fuel dispenser design, and "transferring" the design to a location for constructing the dispenser finds clear support in the disclosure at, for example, Page 4, lines 7-8 (Fig. 3); Page 5, line 7 to Page 6, line 3; Page 7, line 7 to Page 8, line 6; and Page 8, line 14 to Page 10, line 8.

These noted portions of the disclosure describe one illustrative form of the invention, including a computer system having a database of fuel dispenser options, and further having a mouse or keyboard to enable selections of the design options as displayed on a computer screen (Fig. 3) by using a select button in conjunction with pull-down menus and pop-up menus. The selected design can be saved, for example, to a computer storage such as a hard drive. The selected design can be transferred to a manufacturing site using any suitable means, such as a modem. (See, e.g., Page 5, lines 7-17; Page 7, lines 7-12; and Page 9, lines 8-20).

Application No.: 10/040,141
Attorney Docket No.: TOK00-006
Response Dated: January 12, 2006
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In view of the foregoing, Applicant respectfully submits that the specification fully supports the claim recitations referenced by the Examiner, and requests that this objection be withdrawn.

Claims 1-61 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding subparagraphs (a)-(d) of this rejection, the specification clearly links or associates structures to the various functions recited in the claims, as evidenced at least by the foregoing illustrative example of the invention, which Applicant has set forth above in reply to the objection to the specification. In particular, the foregoing example clearly identifies illustrative structures from the specification pertaining to the "displaying", "facilitating selection", "transferring", and "selecting" operations.

Regarding subparagraph (e), Applicant has amended base Claims 1, 21, and 41 to improve the clarity of description.

No new matter is added with these amendments. Applicant respectfully requests entry and consideration of the claim amendments. The claim amendments present no new issues requiring further consideration or search by the Examiner, but merely make grammatical improvement. Indeed, for examination purposes, it appears that the Examiner has already rendered a construction consistent with the grammatical correction, as evident in the remarks found at paragraph 6(e) and 7.

Application No.: 10/040,141
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In view of the foregoing, Applicant respectfully requests that this rejection be withdrawn.

Claims 1-61 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,714,937 to Eynon et al. ("Eynon") in view of U.S. Patent No. 5,602,745 to Atchley et al. ("Atchley").

Applicant submits that one skilled in the art to which the invention pertains would have no reason to consult or have recourse to Eynon. Eynon is not even remotely connected with the general field of the invention (fuel dispensers), nor even the "field of applicant's endeavor" (design and construction of fuel dispensers). MPEP §2141.01(a). There is no reasonable basis why the skilled artisan in the field of fuel dispensers would refer to the disclosure of a transaction system oriented specifically to the purchase of built-to-order personal computers, as set forth in Eynon.

Further, the Eynon disclosure and problems addressed therein are not "reasonably pertinent to the particular problem with which the invention was concerned." MPEP §2141.01(a). Eynon addresses the problems encountered by purchasers of personal computers who must, upon receipt of the computer from the vendor, then undertake the "final operating system (OS) and network setup and configuration process" before the machine can be used in the customer's own computing environment. (Col. 1, lines 28-65.) However, the purchaser in Eynon receives the personal computer not with the standard manufacturing defaults (as before) but with a setup that the customer selects during the ordering process. These personalized setups are tailored, for example, to the user's operating system, software platforms, and network connections. This

Application No.: 10/040,141
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allows the customer to receive a personal computer that can be plugged into the user's environment with little or no reconfiguration or setup. (Col. 2, lines 15-25.)

The problem addressed by Eynon bears no resemblance to the problems addressed by the invention. The invention does not concern itself with matters relating to setups and reconfigurations for a personal computer. (See, e.g., Page 1, lines 8-17 and Page 3, lines 4-18).

Further, there is no basis that the Eynon disclosure "logically would have commended itself to an inventor's attention in considering his problem" (MPEP §2141.01(a)), due to the significant differences in field of technology (fuel dispenser versus personal computer) and the lack of any relatedness of the Eynon problems to the invention.

The rejection attempts to draw a similarity between the respective subject matters of Eynon and the invention by stating that Eynon "discloses a detailed system to customize a product." However, given the singular attention in Eynon to solving problems relating to personal computers, the contention that Eynon has a system to "customize a product" could not reasonably be considered to extend the scope of Eynon's teaching so far as to reach the completely unrelated field of fuel dispensers, nor would the skilled artisan make such a recognition.

Regarding Atchley, as noted in the rejection, this reference relates to "improvements in fuel dispenser electronics design." (Col. 1, lines 5-10.) However, though Atchley is indeed related to fuel dispensers, the mere disclosure in Atchley that there may be "customizing a fuel pump in the design phase" does not itself address the problems confronted by the invention nor

Application No.: 10/040,141
Attorney Docket No.: TOK00-006
Response Dated: January 12, 2006
Reply for Office Action Dated: 13 July 2005

even suggest the subject matter of the invention, e.g., a user-interactive computer-aided process for creating a fuel dispenser design.

Atchley simply discloses a certain fuel dispenser design having certain advantages, namely, a "local operating network for a fuel dispenser to permit modular design and construction with minimal wiring and no unused components." (Col. 1, lines 5-10; Col. 5, lines 45 to Col. 6, line 6.) However, the invention *per se* is not directed to the ultimate end product fuel dispenser as in Atchley, but to developing a particular design process/methodology/system whereby a fuel dispenser is designed by machine assistance according to customer specifications, e.g., a user-interactive computer-aided process for creating a fuel dispenser design. Indeed, Atchley does make certain design selections for its particular fuel dispenser architecture, but this does not amount to any teaching or suggestion that any such "customizing" envisions any machine-assisted design process, much less a user-interactive computer-aided process for creating a fuel dispenser design, as in the invention.

Further to the rejection, the asserted rationale for modifying Eynon in view of Atchley is that "such a modification would have allowed the supplier to more easily respond to the desired types of fuel pumps required by various fuels in different locations." In reply to Applicant's prior remarks that this motivation to make the proposed modification is not found in Eynon or Atchley, the Examiner replies that "the motivation to combine need not be found in the two references." Applicant takes this as an admission that the asserted rationale to make the modification is not expressly or impliedly found in the references.

Application No.: 10/040,141
Attorney Docket No.: TOK00-006
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In reply, Applicant first notes the following:

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. MPEP §2142.

Accordingly, if express or implied prior art teachings are not relied upon as the basis for the motivation, as appears to be the case here, then the motivation to combine must come from somewhere else, i.e., a convincing line of reasoning that as of yet does not appear to have been produced in the rejection.

For example, the purported desirability of "allowed the supplier to more easily respond to the desired types of fuel pumps" already presupposes the existence of the modification as a hindsight construction -- followed by the observation that the combination has such an advantage -- rather than serving initially as a basis for the skilled artisan to look towards Eynon, and then to Atchley, and then make the combination as a supposed obvious modification of Eynon.

Even if, as the Examiner asserts, the skilled artisan would recognize the need to "respond to the desired types of fuel pump required by various fuels in different locations", this recognition at best only points to a different fuel dispenser design and does not at all teach or suggest the fuel dispenser design process set forth in the invention, i.e., a user-interactive computer-aided process/system for creating a fuel dispenser design. Additionally, even if the skilled artisan does make such a recognition, there appears to be no reason (sufficient to establish obviousness) why the skilled artisan would have recourse to an ordering system for a personal computer as disclosed by Eynon.

Application No.: 10/040,141
Attorney Docket No.: TOK00-006
Response Dated: January 12, 2006
Reply for Office Action Dated: 13 July 2005

Applicant respectfully submits that the combination proposed by the Examiner can only be rendered on the basis of impermissible hindsight taken from Applicant's disclosure.

In view of the foregoing, Applicant respectfully submits that Claims 1-61 are patentable over Eynon in view of Atchley, and requests that this rejection be withdrawn.

Applicant respectfully submits that the application is in condition for allowance and requests favorable action in accordance therewith.

If the Examiner has any questions or comments that would advance prosecution of this case, the Examiner is invited to call the undersigned at 260/602-6344.

Respectfully Submitted,

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RJK

Enclosures: Amendments to the Claims
(6 Sheets)
Explanatory Cover Sheet - Page 1
Petition for Extension of Time
Notice of Appeal
Return Postcard

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on: January 12, 2006.

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